

18. (previously presented) The ground connector installation of claim 9, wherein said movable member defines a longitudinal axis, said spade connector defining a plane orthogonal to said axis.

REMARKS

No new claims have been added. Claims 1, 9, and 15 have been amended. Upon entry of the Amendment, claims 1-18 will be pending in the application. Applicant notes that the amendment adds no new matter and is fully supported by the application as filed. For example, Applicant directs the Examiner's attention to page 3 of the as filed application.

Claim Rejections Under 35 U.S.C. §103, Prima Facie Case Not Established

Claims 1-8, 13 and 14 were rejected under 35 U.S.C §103(a) as being unpatentable over United States Patent No. 4,103,986 to Izraeli. Claims 9-13, and 16-18 were rejected as being obvious over United States Patent No. 4,768,963 to Barron in view of United States Patent No. 4,103,986 to Izraeli.

To establish a prima facie case of obviousness three basic criteria must be met. First there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine the reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. See M.P.E.P. §2143.

All Claim Limitations Are Not Taught Or Suggested

It is well established that when even one claimed limitation is not found in the combination of prior art, a rejection under 35 U.S.C. §103 is improper. In re Royka, 490 F.2d 981, 180 USPQ 580 (CCPA 1974).

The references cited by the examiner alone or in combination fail to teach or suggest a ground connector having, at least, a one piece movable member comprising

a movable jaw...and a receiving cavity, said receiving cavity at least partially defines the second guide portion, the ground connector further having a securement means that extends through the movable member for securing said base and movable member.

In particular, Izraeli is asserted by the Examiner to teach or suggest a receiving cavity "between 52 and the movable member". Office Action, Page 2, Paragraph 3, lines 3-4 (with regard to rejection of claims 1-8, 13 and 14); Office Action, Page 4, Paragraph 2, lines 3-4 (with regard to rejection of claims 9-13 and 16-18). Applicant notes that the asserted receiving cavity is isolated from any securement feature by the movable member identified as feature 78 by the Examiner. Izraeli clearly does not teach or suggest, at least, a securement means that extends through the movable member for securing said base and movable member... as found in amended claims 1 and 9, upon which all other claims depend either directly or indirectly. Since at least these claimed elements are clearly not present in the modification or combination as suggested, claims 1- 18 are non-obvious for at least this reason.

Proposed Modification or Combination Devoid of Required Suggestion or Motivation

The prior art reference (or references when combined) must teach or suggest all the claim limitations. See M.P.E.P. §2143.

It is indisputable that in order to properly reach a conclusion as to obviousness pertinent case law requires that "there must be something in the prior art as a whole to suggest the desirability, and thus the obviousness, of making the combination."

Interconnect Planning Corp., v. Fell, 227 USPQ 543, 551 (Fed. Cir. 1985). In determining the differences between the prior art and the claims, the question under 35 U.S.C. §103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious. Stratoflex, Inc. v. Aeroquip Corp., 218 USPQ 871 (Fed. Cir. 1983). Further, the prior art reference must be considered in its entirety, including portions that would lead away from the claimed invention. W.L. Gore & Associates, Inc. v. Garlock, Inc., 220 USPQ 303 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984); see also M.P.E.P. §2141.02. The burden is on the Examiner to demonstrate that the prior art evidences sufficient suggestion of the

desirability of doing what the inventor has done. See M.P.E.P. §2142. At an irreducible minimum, this burden requires this Examiner to apply the facts of the case to "present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references." Ex parte Clapp, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985). Clearly, the Examiner cannot discharge himself from this burden by simply declaring all of the elements of an invention, along with the manner of combining these elements, to be well known in the art. Ex parte Stern, 13 USPQ2d 1379, 1381 (Bd. Pat. App. & Inter. 1989).

The Examiner has not shown the required suggestion or motivation to provide , at least, a securement means that extends through the movable member for securing said base and movable member... as found in amended claims 1 and 9. This suggestion is simply not found in either in the cited references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine the reference teachings.


Proposed Modification or Combination Devoid of Required Reasonable Expectation of Success

Obviousness does not require absolute predictability, however at least some degree of predictability is required. Evidence showing there was no reasonable expectation of success may support a conclusion of nonobviousness. MPEP §2143.02 citing In re Rinehart, 189 USPQ 143 (CCPA 1976). The Examiner has not shown the required expectation of success to provide , at least, a securement means that extends through the movable member for securing said base and movable member as found in amended claims 1 and 9. Izraeli clearly does not , based on at least the teaching of a "free floating" (Izraeli, column 4, line 29) movable plate 76, offer the required expectation of success in arriving at Applicant's claim invention as found in, at least, amended claims 1, and 9. A such a proper rejection under 35 U.S.C. §103 cannot be made.

In summary, Applicants have addressed each of the Examiner's rejections within the present office action. It is believed that the application now stands in condition for allowance and prompt favorable action is thereon earnestly solicited.

Respectfully submitted,

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